

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES J. KAISER

Appeal No. 94-2901
Application No. 07/837,666¹

ON BRIEF

Before WINTERS, DOWNEY and WILLIAM F. SMITH, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision finally rejecting claims 18 through 22. Claims 2 through 4 and 14 through 17, which are the only other claims remaining

¹ Application for patent filed February 14, 1992. According to applicant, this application is a continuation of Application No. 07/067,001, filed June 29, 1987, now abandoned.

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in the application, also stand finally rejected. However,
with respect to the latter claims, no appeal was taken.

REPRESENTATIVE CLAIMS

Claims 19 and 20, which are illustrative of the subject
matter on appeal, read as follows:

19. A culture medium for use in a unitary sterilization
monitoring device, comprising a sterile admixture of water,
protein digests, soluble starch, a phosphate buffer, a salt,
and glycerol in an amount sufficient to support visually
detectable microbial growth, said culture medium being pH and
color stable to repeated subsequent heat sterilizations.

20. A twice sterilized culture medium comprising an
admixture of water with protein digests, minerals, a pH
indicator, and glycerol, wherein said first sterilization is
by heat or filtration and said second sterilization is by
heat, said culture medium being pH and color stable following
said first sterilization.

THE REFERENCES

The references relied on by the examiner are:

Orelski	4,291,122	Sep. 22, 1981
Brockmann	2,950,202	Aug. 23, 1960

Robert Jenness et al. (Jenness), Principles of Dairy Chemistry
346-49 (John Wiley & Sons, Inc. 1959)

A. Atkinson et al. (Atkinson), "Behaviour of *Bacillus*
stearothermophilus Grown in Different Media," 38 Journal of
Applied Bacteriology no. 3, 301-04 (1975)

THE ISSUES

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The issues presented for review are: (1) whether the examiner erred in rejecting claim 19 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Orelski, Atkinson, and the acknowledged prior art in the specification (paragraph bridging pages 5 and 6) "and, if necessary," further taken in view of Jenness or Brockmann; (2) whether the examiner erred in rejecting claims 18 through 22 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention; (3) whether the examiner erred in rejecting claims 20 through 22 under 35 U.S.C. § 112, first paragraph, as based on an original specification which does not provide adequate written descriptive support for the invention now claimed; and (4) whether the examiner erred in rejecting claims 18 through 22 under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure.

DELIBERATIONS

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including Figures 1, 2 and 3, and all of the claims on appeal; (2) applicant's Appeal Brief (Paper No. 31),

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the Reply Brief (Paper No. 34), and the "Answer to Examiner's Supplemental Answer" (Paper No. 36); (3) the Examiner's Answer (Paper No. 33), the first Supplemental Answer (Paper No. 35), and the second Supplemental Answer (Paper No. 37); (4) the above-cited references relied on by the examiner; and (5) the previous opinion and decision issued by another merits panel of the Board in parent Application Serial No. 07/067,001 (Appeal No. 91-2989, mailed January 14, 1992).

On consideration of the record, including the above-listed materials, we reverse the examiner's rejections.

SECTION 103

The facts adduced by the examiner would appear to support a conclusion of prima facie obviousness of claim 19 over Orelski, Atkinson, and the acknowledged prior art in the specification (paragraph bridging pages 5 and 6), further considered in view of Jenness or Brockmann. That, however, does not end the inquiry. See In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986) ("If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by

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experiment, prior art references, or argument, the entire merits of the matter are to be reweighed.").

We have reviewed the objective evidence of nonobviousness in applicant's specification, pages 5 through 8. There, in side-by-side testing, applicant compares prior art Medium I with culture Media II and III representing the claimed invention. The evidence establishes that replacing a monosaccharide such as dextrose with glycerol provides a significant, unexpected improvement in the art, namely, culture media containing glycerol are significantly less sensitive to processing heat conditions and maintain a stable pH. As stated in In re Papesch, 315 F.2d 381, 391, 137 USPQ 43, 51 (CCPA 1963), a composition and all of its properties are inseparable; they are one and the same thing. On these facts, we hold that (1) the specification evidence serves to rebut the examiner's prima facie case of obviousness; and (2) the claimed composition, considered as a whole, would not have been obvious from the cited prior art.

The examiner attempts to "explain away" the data in applicant's specification, arguing that

glycerol has a structure and chemical properties differing substantially from glucose, and would not

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have been expected to be degraded like carbohydrate by the high temperature of steam sterilization to form acid . . . Glycerol not being degraded to form an acid would have been expected to result in a pH stable medium. [Examiner's Answer, page 15].

In our judgment, however, the examiner's argument is not based on adequate evidence or sound scientific reasoning. Rather, we believe that the argument is derived from information provided by applicant in the instant specification, i.e., the examiner's argument is based on the impermissible use of hindsight. The examiner's position to the contrary, notwithstanding, we hold that the objective evidence in applicant's specification, pages 5 through 8, shows that the claimed culture medium provides a significant improvement in the art which would not have been expected at the time the invention was made by a person having ordinary skill in the art.

The rejection of claim 19 under 35 U.S.C. § 103 is reversed.

SECTION 112

Claims 18 through 22 stand rejected under 35 U.S.C. § 112, second paragraph. According to the examiner, the claims do not particularly point out and distinctly claim the

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subject matter which applicant "regards" as his invention because the first and second sterilizations recited in claim 18, the repeated subsequent heat sterilizations recited in claim 19, and the first and second sterilizations recited in claims 20 through 22 are not limited to steam sterilizations. A similar rejection was affirmed by another merits panel of the Board in parent application Serial No. 07/067,001, apparently on the basis of a statement in the previous Appeal Brief that applicant intended to cover only steam sterilization. See Appeal No. 91-2989, mailed January 14, 1992, page 8.

In this appeal, however, applicant makes clear that the Board's . . . interpretation of appellant's arguments in the parent case notwithstanding, appellant has never asserted that steam sterilization was the only type of sterilization useful in the invention. [Appeal Brief, page 9, last paragraph, emphasis added].

Suffice it to say, we find no evidence in this record supporting a conclusion that claims 18 through 22 do not particularly point out and distinctly claim the subject matter which applicant regards as his invention. Applicant's present position, that his contribution goes beyond steam

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sterilization, is amply supported by a consideration of the instant specification in its entirety.

The rejection of claims 18 through 22 under 35 U.S.C. § 112, second paragraph, is reversed.

Claims 20 through 22 stand rejected under 35 U.S.C. § 112, first paragraph, as based on an original specification which does not provide adequate written descriptive support for the invention now claimed. According to the examiner, the original specification does not adequately support a first sterilization by filtration as recited in these claims.

Furthermore, claims 18 through 22 stand rejected under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure. According to the examiner, applicant's disclosure enables only steam sterilization. Therefore, to obviate this rejection, the examiner would require that claim 18 be limited to first and second steam sterilizations; that claim 19 be limited to repeated subsequent steam sterilizations; and that claims 20 through 22 be limited to first and second steam sterilizations.

With respect to these rejections, we agree with the reasoning succinctly stated by applicant in the Appeal Brief,

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pages 4 through 9, sections (6)(A) and (6)(B). For the reasons set forth by applicant, the rejections under 35 U.S.C. § 112, first paragraph, are reversed.

CONCLUSION

We do not sustain the examiner's rejections under 35 U.S.C. § 103, 35 U.S.C. § 112, second paragraph, or 35 U.S.C. § 112, first paragraph.

The examiner's decision is reversed.

REVERSED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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MARY F. DOWNEY)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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WILLIAM F. SMITH)	
Administrative Patent Judge)	

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Phillips, Lytle, Hitchcock, Blaine
& Huber LLP
Intellectual Property Group
3400 Marine Midland Center
Buffalo, NY 14203